

REMARKS

Applicant has carefully reviewed the Office Action mailed March 12, 2004. With this Response, Applicant has canceled claim 28 and amended claims 5, 8, 10, 12, 14, and 16. Claims 1-4 and 29-33 have been withdrawn from consideration. Claims 5-27 are currently pending in this application. It is noted that Applicant has amended and/or cancelled the above-identified claims solely to advance prosecution of the instant application and to obtain allowance on allowable claims at the earliest possible date. Accordingly, no admission may be inferred from the amendments of claims herein. Applicant expressly reserves the right to pursue the originally filed claims in the future.

Claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,904,867 to Herke. This rejection is now overcome because Herke does not disclose the step of imparting indicia comprising a mirrored image to a workpiece so that the mirrored image is readable through the workpiece as recited in amended claim 5.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. 2143.03. In the present case, Claim 5 recites a method of imparting etched indicia to a planar workpiece. Applicant’s claimed method comprises the steps of providing image data, providing orientation data indicating that the etched indicia will comprise a mirrored image, and imparting the indicia to the workpiece with the indicia comprising a mirrored image that is readable through the workpiece.

Herke discusses a laser engraving machine 30 designed to engrave the lid 34 of a casket 36. (Column 3, lines 8-11.) Unlike the method recited in claim 5, Herke does not disclose the step of imparting indicia to a workpiece with the indicia comprising a mirrored image that is

readable through the workpiece. The ordinarily skilled artisan would not have been motivated to modify the method discussed by Herke to yield a method of providing indica comprising a mirrored image because casket lids are normally made of an opaque material. Even assuming, arguendo, that lid 34 of casket 36 was made of a transparent material, the only person in a position to read the mirrored image of the indicia would be a decedent located within the casket 36.

Because Herke does not teach all limitations recited in amended claim 5, Applicant respectfully submits that this claim is now in condition for allowance. Claims 6-7 depend from claim 5 and recite additional limitations, Applicant respectfully submits that these dependent claims are also in condition for allowance.

Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,904,867 to Herke. Herke discusses a laser engraving machine 30 that is designed to engrave the upper surface 32 of a casket 36. (Column 3, lines 8-11.) The casket 36 has pie sections 174, 176 at each end. (Column 7, lines 18-35.) The pie sections 174, 176 intersect the surface 32 at points 178, 180 which define the uppermost height of the casket. Id. A line connecting the points 178, 170 bisects the upper surface 32 of the casket 36. Id. The casket 36 is positioned relative to laser engraving machine 30 so that beams 182,184 from light emitting diodes 168, 170 are close to the points 178, 180, respectively. Id. The light emitting diodes 168, 170 are positioned on the support structure 50 of the laser engraving machine 30 such that a line connecting their respective beams 182, 184 bisects the field 186 within which the engraving on the surface 32 is to be performed. Id.

Applicant's invention as recited in claim 8 is a method of determining a desired indicia location proximate a corner of a workpiece comprising the steps of finding a first edge of a

planar workpiece, finding a second edge of the planar workpiece and determining first and second offset distances. The method further includes the step of positioning an etcher adjacent to an intersection of a first inset line and a second inset line and imparting indicia to the planar workpiece surface at the intersection.

Under 35 U.S.C. 103(a), “[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” One difference between the subject matter of claim 8 and Herke is the location of the engraving or indicia. Applicant’s claim 8 recites a method for locating indicia proximate a corner of a workpiece. Unlike Applicant’s claimed invention, Herke teaches a field of engraving 186 that is centered on the upper surface 32 of a casket 36 with beams 182,184 from light emitting diodes 168, 170 falling on points 178, 180. When Herke teaches that the field of engraving is to be centered on the casket 36, Herke teaches away from a method of positioning indicia near a corner of the casket 36.

In the instant case, the ordinarily skilled artisan would not have been motivated to modify Herke to yield Applicant’s claimed invention because Herke expressly teaches that the field of engraving is centered on the casket. For this reason, Applicant respectfully submits that independent claim 8 is now in condition for allowance. Claim 9 depends from claim 8 and recites additional limitations, Applicant respectfully submits that this dependent claim is also in condition for allowance.

Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,904,867 to Herke. This rejection is now overcome because Herke does not disclose the step of obtaining the dimensions of a workpiece as recited in amended Claim 10.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. 2143.03. Applicant’s invention as recited in claim 10 is a method comprising the step obtaining the dimensions of a planar surface, inputting an approximate desired indicia location, and calculating an optimal indicia location on the planar surface according to the desired indicia location.

Unlike Applicant’s claimed invention, Herke does not disclose the step of obtaining the dimensions of a planar surface. Because Herke does not teach every step of Applicant’s claimed method, this reference cannot render Applicant’s claimed method obvious. Accordingly, Applicant respectfully submits that claim 10 is now in condition for allowance. Claims 11-13 depend from claim 10 and recite additional limitations; Applicant respectfully submits that these claims are also in condition for allowance.

Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,904,867 to Herke. Applicant’s invention as recited in claim 14 is a method comprising the steps of providing a planar workpiece and determining a location proximate a corner of the planar workpiece where indicia will be imparted to the planar workpiece. The method also comprises the steps of finding a first edge of a planar workpiece, finding a second edge of the planar workpiece and determining first and second offset distances. An etcher is positioned adjacent to an intersection of a first dimension and a second dimension and indicia is imparted to the planar workpiece surface at the intersection.

Unlike Applicant’s claimed invention, Herke teaches a field of engraving 186 that is centered on the upper surface 32 of a casket 36. In the method taught by Herke, the casket 36 is positioned so that beams 182,184 from light emitting diodes 168, 170 fall on points 178, 180. Herke teaches that points 178, 180 are located where pie sections 174, 176 of the casket intersect

its upper surface 32. (Column 7, lines 18-35.) A line connecting the points 178, 170 bisects the upper surface 32 of the casket 36. Id. A line connecting the light emitting diode beams 182, 184 bisects the field 186 within which the engraving on the surface 32 is to be performed. Id.

In the instant case, the ordinarily skilled artisan would not have been motivated to modify Herke to yield Applicant's claimed invention because Herke expressly teaches that the field of engraving is centered on the casket. For this reason, Applicant respectfully submits that independent claim 14 is now in condition for allowance. Claim 15 depends from claim 14 and recites additional limitations, Applicant respectfully submits that this dependent claim is also in condition for allowance.

Claim 16 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,904,867 to Herke. This rejection is now overcome because Herke does not disclose the step of testing a workpiece as recited in amended claim 16.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." M.P.E.P. 2143.03. Applicant's invention as recited in amended claim 16 is a method comprising the steps of determining window specification data by testing a workpiece, transmitting the window specification data to an indicia imparer, and imparting indicia on a planar surface of the workpiece. Unlike Applicant's claimed invention, Herke does not disclose the step of determining window specification data by testing a workpiece.

Because Herke does not teach every step of Applicant's claimed method, this reference cannot render Applicant's claimed method obvious. Accordingly, Applicant respectfully submits that claim 16 is now in condition for allowance. Claims 17-28 depend from claim 16 and recite

additional limitations; Applicant respectfully submits that these claims are also in condition for allowance.

In light of the above discussion, Applicant respectfully submits that all of the claims are in condition for allowance and courteously requests prompt notice of the same. If a telephone conference would be of assistance, please contact the undersigned practitioner at 612/492-7000.

Respectfully submitted,



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